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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,734	02/27/2004	Ramnath N. Iyer	EI-7617	6096

34769 7590 10/12/2006

NEW MARKET SERVICES CORPORATION
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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,734

Applicant(s)

IYER ET AL.

Examiner

James Goloboy

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/18/2004, 2/22/2006, 9/8/2006.

DETAILED ACTION

Claim Objections

1. Claim 36 is objected to because of the following informalities: The limitation "improved compatibility" is undefined within the context of the claim as it is not clear what the compatibility is improved in relation to. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 29-33 recite methods of improving various properties of a lubricating or power transmission fluid, but the actual steps of the method simply include lubricating an object with the fluid, which does not change the properties of the fluid. Additionally, the methods of Claims 29 and 30 are identical and should be combined into a single claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12-27, and 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Papay.

Papay, in column 59 lines 17-49 (Example XXI) discloses a lubricant composition comprising a major amount (82.230%) of a base oil, and a minor amount of an additive composition, which includes 5.300% by weight of a polymethacrylate viscosity index improver, meeting the limitations of Claims 1-5. Since the composition of Papay meets the compositional limitations of Claims 1 and 9, it must also provide the anti-shudder properties recited in Claims 1 and 9. In column 47 lines 38-49 Papay discloses that the base oil may be a natural oil, a synthetic oil, or a mixture thereof, as recited in Claim 6. The composition does not contain a dispersant viscosity index improver, as recited in Claim 7. In column 51 line 16, Papay teaches that the composition may be used as an automatic transmission fluid, as recited in Claim 8, and also a manual transmission fluid. The use of the composition as an automatic transmission fluid also anticipates an automatic transmission lubricated with the fluid, as in Claim 10.

Papay also discloses in column 47 lines 14-33 that the compositions may further comprise a seal swell agent, which in column 47 lines 15-16 are taught to improve the elastomer compatibility of the compositions. The addition of a seal swell agent to Example XXI produces a composition that meets the limitations of Claims 12-18 and 21-27. In column 5 lines 25-34, Papay discloses that combinations of other components of the composition (component a and component b) also aid elastomer compatibility, including cases where the elastomeric component is a seal or gasket, as recited in Claim 19, and cases where the elastomer is composed of nitrile rubber, a fluoroelastomer, or a silicone elastomer, as recited in Claim 20.

The compositions and properties disclosed above meet Claims 29-36. The use of the composition as a transmission fluid inherently discloses lubricating the transmission with the fluid, as in Claims 29-30. The improved compatibility of the composition including a seal swell agent with elastomeric components inherently discloses lubricating the elastomers with the composition, as in Claims 31-34. As the composition comprises a base oil and a non-dispersant viscosity index improver, the process of making it must at some point involve adding the viscosity index improver to the base oil, as recited in Claims 35-36.

6. Claims 1, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda (U.S. Pat. No. 6,048,826).

In column 1 lines 4-10, Ikeda discloses a lubricating composition for use in a continuously variable transmission, as recited in Claims 11 and 28. In the abstract,

Art Unit: 1714

Ikeda teaches that these compositions provide anti-shudder performance, as recited in Claim 1. In columns 5-6 (Tables 1-1 and 1-2) Ikeda discloses numerous compositions that meet the limitations of Claims 1, 11, and 28, as the compositions include a major part of a base oil and a minor port of a non-dispersant polymethacrylate viscosity index improver.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/788,734
Art Unit: 1714

Page 6

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